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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,988	03/30/2006	Jordi Tormo i Blasco	50000158PUS1	1787
2292 7590 09/05/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
MANOHAR, MANU M				
ART UNIT		PAPER NUMBER		
4161				
NOTIFICATION DATE		DELIVERY MODE		
09/05/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/573,988

**Applicant(s)**

TORMO I BLASCO ET AL.

**Examiner**

MANU MANOHAR

**Art Unit**

4161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date March 30, 2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **The status of the Claims**

Claims 1-17 are pending in the application.

### **Priority**

This application has the filing date of March 30, 2006 and is a national stage application of PCT/EP04/11025, filed on October 02, 2004, and claims foreign priority to Germany patent application 10347660, filed on September 10, 2003. This application is considered with the priority date of September 10, 2003.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term 'an amount of from 1 to 1000 g/100 kg' in claims 8 and 17 renders the claim indefinite. The term '1 to 1000g/100 Kg' is not defined by the claim and the specification does not provide a standard for ascertaining the requisite degree and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1- 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 is drawn to a fungicidal mixture, which mixture comprises triazolopyrimidine derivative of formula I and fenhexamid of formula II, in a synergistically effective amount. The claim encompasses the fungicidal mixture with triazoloderivatives and fenhexamide in synergistically effective amount. This mixture is to treat the pathogens especially harmful fungi in the crops like rice and wheat. There are several studies disclosed that triazole derivatives and fenhexamid are effective fungicidal composition for variety of plants like vines, grain crops, top fruits and vegetables (For example refer WO 98/46607, page 19). The studies indicate that this composition is found to be effective in controlling various groups of fungi (WO 98/46607, page 2). However in the specification the details of derivatives of triazolopyrimidine is not specifically given. The triazolopyrimidine derivatives encompasses numerous compounds and it is not clear how one skilled in the art would choose a specific compound for the composition. Applicant description about the preparation of fungicidal

mixtures on pages 3 and 4 of specification is noted. However the description is not detailed enough and the person skilled in the art can not readily determine the specific compounds from the derivatives for the preparation of the mixtures without undue experimentations. The working examples are lacking. Claims 2-17 which reads on the claim 1 are also rejected.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cotter et al, US Patent 6, 277,856 in view of Pees et al., (International Patent Application WO 98/46607 (listed in IDS)).

Claim 1 is drawn to a fungicidal mixture, which mixture comprises: triazolopyrimidine derivative of formula I and fenhexamid of formula II, in a synergistically effective amount.

Cotter et al teaches the fungicidal compositions comprising at least one azolopyrimidine (Abstract- a) and one fungicidal active ingredient including fenhexamid (Abstract - b) and applying effective amount synergistically for controlling the growth of pathogenic fungi (abstract). Cotter et al do not specifically teach triazolopyrimidine

derivative in the composition. However Pees et al teaches the use derivatives of triazolopyrimidine derivatives in a fungicidal mixture (Abstract, page 3 line 1-17)

It would have been prima facie obvious to one of the ordinary skill in the art at the time of invention to modify the composition of Cotter et al in view of Pees et al to have effective composition for fungal treatment. There is a need in the art to effectively manage the fungi especially for crops like rice with minimal application of the agents as well as minimal resistant development to the agents. The composition with triazolopyrimidine and fenhexamid derivatives would serve this purpose. One of the ordinary skill in the art would have been motivated to develop an effective fungicidal mixture containing the well characterized triazolopyrimidine derivatives and fenhexamid in a composition. Since Cotter et al teachings disclosed that composition with azolopyrimidine derivatives and fenhexamid can be applied to several pathogenic fungi one of ordinary skill in the art would have a reasonable expectation that a modification of the composition with triazolopyrimidine would be successful. The combined teaching of Cotter et al in view of Pees et al makes it prima facie obvious to one of ordinary skill in the art at the time of the invention to substitute triazolopyrimidine for azolopyrimidine in a mixture and develop an effective fungicidal composition.

Claim 2 is drawn to the fungicidal mixture as claimed in claim 1 comprising the compound of the formula I and the compound of the formula II in a weight ratio of from 100:1 to 1:100. Cotter et al teaches the ratio of the compounds in the mixture can be from 1:100 to 100:1 (Column 5 line 13-15).

Claim 3 is drawn to a fungicidal composition comprising a liquid or solid carrier and a mixture as claimed in claim 1. Claim 10 is drawn to a fungicidal composition comprising a liquid or solid carrier and a mixture as claimed in claim 2. Cotter et al teaches the fungicidal mixture comprise a carrier that can be a liquid or solid form (Column 5 line 39-41).

Claim 4 is drawn to a method for controlling rice-pathogenic harmful fungi, which comprises treating the fungi, their habitat or the seed, the soil or the plants to be protected against fungal attack with an effective amount of the fungicidal mixture as claimed in claim 1. Cotter et al teaches the method for controlling pathogenic fungi on plants such as rice (Column 8 line 52-56). Cotter et al also teaches the method of treating for plant, seed, foliage, or soil (Column 5 line 34-39) and it would be obvious to one of ordinary skill in the art to use the effective amount for this purpose.

Claim 5 is drawn to a method according to claim 4, wherein the compounds of the formulas I and II are applied simultaneously, that is jointly or separately, or in succession. Claim 11 is drawn to a method wherein the compounds of the formulas I and II as set forth in claim 1 are applied simultaneously, that is jointly or separately, or in succession. Cotter et al teaches the application of the component of the composition simultaneously or in succession (Column 8 line 18 -20)

Claim 6 is drawn to the method according to claim 4, wherein the mixture is applied in an amount of from 5 g/ha to 2000 g/ha. Claim 12 is drawn to a method wherein the mixture as claimed in claim 1 is applied in an amount of from 5 g/ha to 2000 g/ha. Claim 13 is drawn to a method wherein the mixture as claimed in claim 2 is

applied in an amount of from 5 g/ha to 2 000 g/ha. Cotter et al teaches the composition can be applied 1 to 2000 g/ha (grams per hectare)(Column 4 line 66-68).

Claim 9 is drawn to a process for preparing a fungicidal composition comprising: extending the active compounds of the formula I and the formula II as set forth in claim 1 with at least one solvent and/or at least one carrier. Cotter et al teaches the preparation of the fungicidal composition can be in the form of liquid and can be made with solvents (Column 5 line 39-42, 56 -66).

Claim 7 is drawn to the method as claimed in claim 4, wherein the mixture is applied in an amount of from 1 to 1000 g/100 kg of seed. Claim 14 is drawn to the method as claimed in claim 5, wherein the mixture is applied in an amount of from 1 to 1000 g/100 kg of seed. Claim 15 is drawn to a method wherein the mixture as claimed in claim 1 is applied in an amount of from 1 to 1000 g/100 kg of seed. Claim 16 is drawn to a method wherein the mixture as claimed in claim 2 is applied in an amount of from 1 to 100 g/100 kg of seed. Cotter et al do not specifically teach the amount for 100g of seed however it teaches the range of active ingredients for 1000ml solvent (Column 7 Table line 15 -52) and also it teaches the composition contain active ingredients from 0.5% to 95% hence the teaching would encompass the amount in the instant claims. In addition it would be obvious to one of ordinary skill in the art to modify the concentration of the composition according to the purposes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MANU MANOHAR whose telephone number is



(571)270-5752. The examiner can normally be reached on Mon - Thu 9.00AM to 4.00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, PATRICK Nolan can be reached on 571-272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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MM

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